

Application No. 09/988,548
Applicant: Bernd LUHMANN et al
Amendment Under 37 CFR §1.116 dated June 24, 2004

not coextensive, there is no same invention double patenting, and the Examiner should reconsider and withdraw this rejection.

MPEP §804 (II)(A) provides the following:

“In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. ‘Same invention’ means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a ‘halogen’ substituent is not identical to or substantively the same as a claim reciting the same compound except having a ‘chlorine’ substituent in place of the halogen because ‘halogen’ is broader than ‘chlorine.’ On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of ‘36 inches’ defines the same invention as a claim reciting the same widget having a length of ‘3 feet.’ [Emphasis added.]”

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The halogen/chlorine example is especially pertinent because chlorine would normally anticipate halogen and vice versa (see, e.g., *Bigham v. Godfredsen*, 8 USPQ 2d 1266 (Fed. Cir. 1988)). Nevertheless, as the above-quoted portion of the MPEP makes crystal clear, the fact that the claims are not coextensive because halogen is broader than chlorine negates any same invention double patenting.

In the same manner, the fact that the instant claims embrace a backing comprising or consisting of a *multiple* layer foam material whereas the claims of the patent require a backing consisting of a *single* layer foam material negates any same invention double patenting. While the instant claims may read on the backing of the patent, and, thus, the patent claims might anticipate the instant claims, the two sets of claims are not coextensive. The instant claims are broader than the patent claims and, analogously to the halogen/chlorine example, that difference in scope precludes any same invention double patenting.

The Examiner is also respectfully requested to consider carefully the language of the second paragraph of form paragraph 8.31, which is actually reproduced at the top of page 2 of the Office Action dated February 5, 2003. That form paragraph cautions that the same invention double patenting rejection can be overcome by "canceling or amending the conflicting claims so *they are no longer coextensive in scope* (emphasis added.)" The instant claims are broader than the patent claims, and, thus, the two sets of claims already are not coextensive in scope.

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Applicants respectfully submit that the Examiner should reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 24-35 were rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,372,335. In response, Applicants submit a terminal disclaimer relative to the patent.

Claims 12-35 were rejected under 35 U.S.C. § 103(a) as being obvious over WO 95/06691 (hereinafter "the cited reference" or "Bries.") In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner says that Applicants have ignored the Examiner's rationale behind the rejection. Applicants have done no such thing. Instead, Applicants have merely tried to show that the Examiner's rationale is not well taken.

At the top of page 3 of the Office Action, the Examiner speaks about the "last fifteen words of applicants' claim 24." Apparently, this is in response to the argument begun in the first full paragraph on page 4 of the request for reconsideration dated May 5, 2003.

There, Applicants reproduced the last forty-nine words of claim 24, but the Examiner only focuses on the last fifteen as they, in his view, support his position. However, Applicants reproduced the last forty-nine words of this claim to show that what Applicants invented is

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fundamentally different from what Bries describes, and, therefore, the Examiner's rational is incorrect.

While the Examiner is correct that the end point here is the same as that of Bries, i.e., that the backing does not tear when the adhesive tape is removed from the substrate, the manner in which this is accomplished is brought about by Applicants and Bries in completely different ways. Certainly, a common end point cannot render unpatentable every manner of reaching that end point. Consequently, the Examiner cannot properly rely on the last fifteen words of claim 24 while ignoring the immediately preceding thirty-four words of claim 24. Instead, the Examiner must consider all of the words and limitations of the claim. When this is done, it is clear that Brie does not teach or suggest the present invention.

To belabor the obvious, the adhesive tapes both of the present invention and Bries comprise a backing and adhesive adhered thereto. As Applicants have discovered, either the backing or the adhesive or both can be manipulated in order to ensure that the backing does not tear when the adhesive tape is removed from the substrate.

Bries ensures that the backing does not tear when the adhesive tape is removed from the substrate by manipulating the *backing*. Thus, Bries, requires that the backing *itself* be so strong as to resist tearing when the adhesive tape is removed. As can be taken from Bries at page 1, last line, and page 2, first line, the backing material and thickness is chosen so that the backing does not rupture before the tape is completely removed from the substrate. This same object is

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repeated at page 2, lines 12-13 and 25-26. Thus, in all three of Bries embodiments, the backing thickness and material is chosen so that it must not rupture. The idea is repeated throughout Bries, for example, at page 5, lines 14-15, wherein it is taught that the polymeric film layer is used to increase "the load bearing strength and rupture strength of the tape." See, also, the second paragraph on page 8, wherein it is taught that the backing thickness is important, and can vary somewhat, but must be selected so that "it possesses sufficient integrity" and exhibits "sufficient physical properties and [is] of a sufficient thickness to achieve that objective."

A problem with Bries approach is that it limits the types of materials that are suitable as backings, and also the thicknesses of these. The present inventors overcame these limitations of Bries in a novel and unobvious manner.

Instead of relying on the nature of the *backing* to provide tear resistance, Applicants rely on the nature of the *adhesive* to provide tear resistance. By manipulating the adhesive formulation and thickness, Applicants have discovered that it is now possible to use many different backing materials, and thicknesses that could not be used following Bries' teachings.

The Examiner says the reference uses the same genus of the adhesive as do Applicants. Without conceding the point, Applicants submit they use these adhesives in a different way as explained above. Accordingly, the fact that the types of adhesives might be the same does not render obvious Applicants' fundamentally different manner of using the adhesives.

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The Examiner also says that “with respect to the amount of adhesive present, i.e. layer thickness, this is clearly a parameter within the skill in the art.” Applicants respectfully disagree. Applicants are the first to discover and describe how adhesive type and thickness could be manipulated to protect an adhesive tape from tearing when the adhesive tape is removed from a substrate. While under normal circumstances, changing thickness might be an obvious expedient, under the present circumstances it is not. *See, for example, In re Antoine*, 195 USPQ 6, 8-9 (CCPA 1997), holding an exception to the general rule that it is obvious to optimize parameters applies when the parameter optimized was not known to be a result-effective variable. The Examiner has not shown the nature and thickness of the adhesive to have been a recognized result-effective variable regarding the tearing of the adhesive tape as it is removed from a substrate. In the absence of such a showing, the Examiner cannot have established that it would have been obvious to manipulate the adhesive to provide the benefit now claimed.

The last forty-nine words of claim 24 provide:

“the backing is selected such that *the backing would tear if pulled in the absence of said self-adhesive composition* with the same stripping force necessary to remove said adhesive tape from said substrate, *but the backing does to tear* when said adhesive tape is removed from said substrate.” [Emphasis added.]

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The first thirty-four words provide that the backing would tear if not for the adhesive. This language, in and of itself, distinguishes the present invention from Bries since Bries teaches that the backing material is strong enough that it does not tear. In contrast, the present invention contemplates backings that would tear if not for the presence of the adhesive.

The last fifteen words of claim 24 provide that in spite of the choice of the backing, the adhesive tape does not tear when the adhesive tape is removed from the substrate. Since the backing would tear in the absence of the adhesive, but the adhesive tape does not tear, it should be clear that claim 24 mandates that the adhesive plays a role in the lack of tearing.

Thus, claim 24 succinctly captures the essence of the present invention, which is quite different from Bries' invention. Whereas Bries prevents tearing by choosing a very strong backing, Applicants accomplish the same result by combining a weaker backing with a proper choice of adhesive characteristics so as to overcome the weakness of the backing.

Respectfully, the present invention is nowhere taught or suggested by Bries. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to

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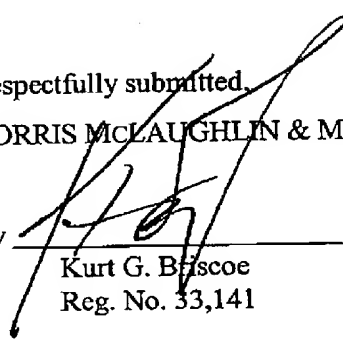
telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (10 pages total) is being transmitted via facsimile to the United States Patent and Trademark Office on the date indicated below:

Date: June 24, 2004

By


Jennifer Archer